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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,243	08/28/2001	Geoffrey B. Rhoads	P0423	6983

23735 7590 09/26/2003

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 100
TUALATIN, OR 97062

EXAMINER

VU, VIET DUY

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 09/26/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/941,243

Applicant(s)
Rhoads

Examiner
Viet Vu

Art Unit
2154



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 2, 2003 (request for RCE)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☒ Claim(s) 16-18 and 23-31 is/are allowed.
- 6) ☒ Claim(s) 7-15 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 13 6) ☐ Other:

Serial No. 09/941,243

DETAILED ACTION

Non-Art rejections:

1. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1970); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

2. Claim 22 is rejected under the judicially created doctrine of double patenting as being unpatentable over prior U.S. Patent No. 6,286,036.

Serial No. 09/941,243

Although the conflicting claims are not identical, they are not patentable distinct from each other because claim 6 of prior patent include all limitations required in current claim 22.

Art Rejections:

3. The texts of 35 U.S.C. § 102(e) and 103(a) cited in the previous office action are hereby incorporated by reference.

4. Claims 7-10, 12-14 and 19 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Tow, European patent application No. 493,091.

Tow discloses a system and method for embedding linking data onto an image comprising:

- a) receiving digital data corresponding to a graphic image (see col 3, lines 29-38),
- b) steganographically encoding the image to hide a digital binary code representing a hyperlink pointer (col 3, lines 38-44 and col 4, lines 51-57),
- c) printing the image on physical medium for distributing to user who can decode the address information and use the embedded hyperlink pointer to establish a link to the Internet (see col 1, lines 32-40 and col 4, lines 1-23).

Serial No. 09/941,243

5. Claims 11, 15 and 20-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tow.

Per claims 11 and 20-21, Tow teachings are still applied as set forth in item 4 above. Tow does not explicitly teach accessing a remote data structure to obtain a network address. An official notice is taken that the use of a domain name server (DNS) to resolve network addresses in the Internet is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a conventional DNS in Tow because it would have enabled resolving a network address and establishing a link in the Internet.

Per claim 15, it would have been further obvious to one of ordinary skill in the art to apply Tow's teaching to embed digital information onto a color image (see col 1, lines 14-25).

Allowable Subject Matter:

6. Claims 16-18 and 23-31 are allowed over prior art of record.

Response to Amendment:

7. Applicant's arguments filed on 9/2/03 with respect to claims 7-15 and 19-21 have been fully considered but they are not deemed persuasive.

Serial No. 09/941,243

Applicant alleges that Tow's teaching of embedding digital data in a hardcopy print is not enabling.

This is not found persuasive. It is submitted that the reference must be read in light of skill level in the art. Since steganographical technique was generally known at the time of Tow's invention (see col 1, lines 41-58), detailed descriptions of this technique would not be required to enable the teaching. Moreover, any patents are presumed to be valid until proven otherwise by the courts. The examiner is not required to show that a patent is valid or enabling.

Conclusion:

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Friday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng An, can be reached on (703) 305-9678. The fax phone number for this Group is (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



VIET D. VU
PRIMARY EXAMINER

V. Vu
9/12/03